# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/780,504 | 02/12/2001 | Magnus Nilsson | 003300-743 | 7099 |

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|---|---|
| 7590     01/12/2005 | **EXAMINER** |
| Benton S. Duffett, Jr. | MCCLELLAN, JAMES S |
| BURNS, DOANE, SWECKER & MATHIS, L.L.P. | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3627 | |

. P.O. Box 1404
Alexandria, VA  22313-1404

DATE MAILED: 01/12/2005

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UNITED STATES PATENT AND TRADEMARK OFFICE

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# BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/780,504
Filing Date: February 12, 2001
Appellant(s): NILSSON, MAGNUS

William Hughet
<u>For Appellant</u>

## EXAMINER'S ANSWER

This is in response to the appeal brief filed November 1, 2004.

## (1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

## (2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

## (3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

## (4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

## (5) *Summary of Invention*

The summary of invention contained in the brief is correct.

## (6) *Issues*

The appellant's statement of the issues in the brief is correct.

## (7) *Grouping of Claims*

The rejection of claims s 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

## (8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

*(9)*     ***Prior Art of Record***

2001/0027420                 BOUBLIK et al.                 10-2001

*(10)*    ***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent

Publication No. US 2001/0027420 A1 (Boublik et al.).  Please refer to the Final Rejection

(3/2/04) for a detailed analysis of the rejection.

*(11)*    ***Response to Argument***

On page 4, first full paragraph (arguments continued through 2nd paragraph of page 5),

Appellant argues that Boublik is "completely and expressly silent regarding any banks, banking

applications, or banking transactions whatsoever."  As related to claim 1, Appellant argues that

Boublik fails to disclose any data in a banking service application being subsequently used an

accounting information in an account service application.  Appellant's statements prove that

Appellant has not fully reviewed Boublik, because Figure 9 of Boublik discloses a "Banking

Partner" in the high level architecture of the invention.  Therefore, Boublik is not silent with

regard to banks, banking applications, or banking transactions.  It is Appellant's position that

Boublik fails to disclose a banking service application as required in claim 1.  However,

Appellant has failed to provide an express definition for the term "banking service application".

Appellant's citation of the paragraph bridging pages 5-6 is merely exemplary in nature.  On page

6, lines 2-4, Appellant discloses that "The banking service application could preferably provide

usual banking services such as payments, money transfers, etc."  "Absent an express definition

in their specification, the fact that appellants can point to definitions or usages that conform to

their interpretation does not make the PTO's definition unreasonable when the PTO can point to

other sources that support its interpretation." *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029.The

Examiner relies upon a dictionary definition. *Merriam Webster's Collegiate Dictionary*, tenth

edition defines "bank" as <u>an establishment for the custody, loan, exchange, or issue of money, for</u>

<u>the extension of credit, and for facilitating the transmission of funds</u> (see Advisory Action on

8/5/04).

Boublik discloses a server that includes applications to 1.) collect relevant online

procurement transaction information and 2.) converts the information to an accounting-package

(see at least paragraph 0032). Using the Examiner's dictionary definition, Boublik's application

for collecting relevant online procurement transaction information is analogous to Appellant's

banking service application because Boublik's application at least exchanges money and

facilitates the transmission of funds via the "Banking Partners" of Figure 9. As required by the

claim 1, Boublik then takes the transaction information via the account service application for

updating the book-keeping database (see at least paragraphs 0032, 0058 and 0060).

On pages 5-8, Appellant repeats similar arguments for claim 9 as previously argued for

claim 1. The Examiner maintains the same responses (as set forth above for claim 1) to

Appellant's arguments related to claim 9.

On page 8, second full paragraph, Appellant argues that certain features of claims 5 and

12 are not anticipated by Boublik. More specifically, Appellant argues that Boublik fail to

disclose account data comprising information of value added tax related to transaction. Value

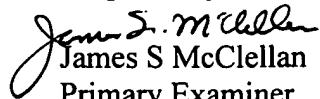added tax is basically a supply chain tax that is imposed on each stage of the production process.

The sales tax of a transaction is the portion of the value-added tax at the retail level of the supply chain. Therefore, Boublik at least broadly discloses value-add tax data related to the transaction.

In conclusion, Boublik anticipates every limitation of claims 1-20 but at certain instances merely uses terminology that is different from Appellant's claims. The fact that Boublik fails to include the term "banking service application" does not preclude Boublik's system from meeting all the claim limitations. As set forth above, Boublik's transaction processing system uses Banking Partner's (see Figure 9) to collect transaction data which is then updated in a book-keeping database. It is noted that Appellant is attempting to overcome Boublik using the argument that Boublik fails to disclose a "banking service application", but Appellant has failed to expressly define banking service application. The only type of transaction Appellant requires in the claims is a "payment" (see claim 2), which is clearly anticipated by Boublik's online procurement transaction processing system. Finally, it is noted that Appellant's chief argument is that Boublik is "completely and expressly silent regarding any banks, banking applications, or banking transactions whatsoever." As set forth, Boublik discloses "Banking Partners" in the high-level architecture of the system in Figure 9.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James S McClellan
Primary Examiner
Art Unit 3627


jsm
January 7, 2005

Conferees
J. Thomas
R. Zeender


Benton S. Duffett, Jr.
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404